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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT PAPER NUMBER

2653

DATE MAILED: 01/22/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/131,941

Applicant(s)

ISHII ET AL.

Examiner

Aristotelis M Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 19-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 19-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 18 September 2000 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/131/941.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5/2/01.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Prosecution Application

The request filed on 5/2/01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/131941 is acceptable and a CPA has been established. An action on the CPA follows. The certified English translation(s) of the priority documents have been received.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/131,941, filed on 8/10/98.

Drawings

The correction to the drawings of 9/18/2000 is approved by the examiner.

The IDS of 5/2/01 has been received and entered.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "table producing unit" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 U.S.C. § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3, and 19-29 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Not only is the aggregate audio information critical or essential to the practice of the invention, but the particular structure of the medium itself is also considered critical, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

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In particular, with respect to independent claims 1, and 19 are drawn to an information storage medium. Nevertheless, none of the independent claims, or any dependent claim thereof provide for any physical structure of the medium (material, substrate, etc). All the limitations recited deal with the information found thereon; however, no specifics of the medium are found. Hence the examiner concludes that critical element(s) disclosed with respect to the structure of the medium is not provided for and hence these claims fail accordingly.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 22--29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 is an improper dependent claim that is it is a reproduction apparatus improperly incorporating subject matter from parent claim 19, a product claim. The examiner recommends rewriting claim 22 in independent form. Dependent claims 23-25 suffer accordingly.

Claim 26 is an improper dependent claim, that is it is a reproduction method improperly incorporating subject matter from parent claim 19 – a product claim. The examiner recommends rewriting claim 26 in proper independent form. Dependent claims 27-29 suffer accordingly.

AS FAR AS THE CLAIMS RECITE POSITIVE LIMITATIONS, the following rejections are made.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371⁹ of this title before the invention thereof by the applicant for patent.

4. Claims 1-3, 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Heo et al.

The reference is relied upon for the reasons of record. Applicants' arguments re this reference as presented in the communication of April 2, 2001 are not convincing. Again, applicants' attention is drawn to those previously identified sections of the Heo et al document. Additionally, in response to applicants' argument of what is lacking, the examiner refers applicants to the description of the audio title information management table. This clearly meets applicants' "aggregate attribute information".

With respect to new claim 19, applicants' attention is drawn to the description of figures 5, 14, and 15. Although figure 5 refers to one audio pack, obviously because there is a multitude of audio packs described with respect to figures 5a – e (pcm, dolby, mpeg 1 and 2) the examiner considers the plurality of audio packs to be present. The remaining limitations of claims 19 and dependent claims 20 & 21 are considered self evident and no further elaboration is made.

5. Claims 1-3,4-6, rejected under 35 U.S.C. 102(e) as being anticipated by Moriyama et al.

With respect to claim 1, an information storage medium is disclosed which has recorded thereon, all types of information, including a plurality of audio information. The examiner interprets the phrase "unit audio" and "audio packs" to be one and the same. Such audio information units are found in the references.

Additionally, further review of the document shows that not only is there "aggregate audio information" (claim 1), but also a plurality of audio tracks (claim 19). See the description of the audio packs, tracks in the reference.

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Unit attribute information, and plurality of audio management information areas (which the examiner interprets as being one and the same) are also found in the above document.

Finally, the centralized audio attribute information area, the aggregate attribute information (claim 1) is found with reference to figure 14, item 14d, and the attribute information 12 found in control section 11. The limitations of the dependent claims are considered self evident.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the

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examiner to consider the applicability of 35 U.S.C. 103^o and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4-15 are rejected under 35 U.S.C. 102 (e) as anticipated by Heo et al or alternatively under 35 U.S.C. 103 (a) as being unpatentable over Heo et al as applied above, and further in view of wither Yamamoto et al or Yoshio et al.

The references are relied upon for the reasons of record.

Again, applicants' arguments with respect to the primary reference Heo et al is not convincing.

As far as the examiner can ascertain from the Heo reference, the record medium is read, hence a reading unit exists, the information read is stored, hence a storage unit exists, input from a user for reproduction is provided from, hence an input unit exists, because attributes for the audio information is changed/capable of changing between audio modes, not only must there be a reproducing unit, but an obtaining unit, a determining unit and an attribute changing unit present in Heo. By necessity the time limitation as recited in claims 5 and 6 are present.

With respect to apparatus claims 7 – 9, claim 7 in addition to the elements stated above with respect to claim 1 recites a table producing unit, and function thereof which is disclosed in Heo et al at col. 12 lines 22 plus, these claims are met as well.

As part of the overall system controller's responsibility, appropriate decoding of the selected audio tracks containing the audio information is inherently present. When the information is changed, The controller inherently instructs the appropriate servo unit to move the reproducing unit to the next audio track/pack/segment/section/location in the sequence of information to be reproduced as instructed by the user through his input. Accordingly, there is a delay capability present in order for the mechanics to catch up with the electronics. The attributes of each audio segment is checked in order for the audio information to be properly decoded, and inherently if such attributes are not the same appropriate changes in the attribute settings commence for the next subsequent information.

If applicants' can convince the examiner that such electronic capability with respect to the delay is not present in the above Heo et al system, then the examiner would rely upon either Yamamoto et al or

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Yoshio et al to teach such. – permit the selection of appropriately designated locations to reproduce the desired audio segments.

With respect to Yamamoto, see figure 14.as further analyzed on pages 5 & 6 of the Office action dated 4/14/2000.

It would have been obvious to one of ordinary skill in the art to modify the base reference of Heo et al with the teaching(s) from either Yamamoto et al or Yoshio et al to include the appropriate capability of selecting the designated information track for the proper audio output to be decoded in order of playback in accordance with the change in attributes.

Claims 10-15 are drawn to the method of operating the apparatus of claims 4-9 and hence are present/met when the above system operates.

7. Claims 4- 15 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Moriyama et al further considered with either Yamamoto et al or Yoshio et al.

Applicants' attention is drawn to figures 9 – 12 and the associated description thereof. Again, the reading unit, storage unit, input unit, reproducing unit, obtaining unit, determining unit and attribute changing unit are present in the above Moriyama et al system, other wise it would not permit the user to select an audio segment/track and provide for the reproduction of such as desired. Because the audio information can be writing in a plethora of attributes, and the system provides for reproduction thereof notwithstanding the differences in attributes, the examiner considers all elements claimed (and associated method limitations) as present.

Again, with respect to Yamamoto et al or Yoshio et al, if applicants can convince the examiner that the ability/elements to permit the changing of attributes and delay thereof are not inherently present in Moriyama et al, then the examiner would rely upon either Yamamoto et al or Yoshio et al as stated above to supply such. The reasons for combining the references are the same as stated above in paragraph 6.

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8. Claims 22-29 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Moriyama et al further considered with either Yamamoto et al or Yoshio et al.

With respect to claims 22 –25 as proper reproduction apparatus, the Moriyama et al reference is relied upon for the reasons stated in paragraph 7 above.

With respect to claims 26- 29 as proper reproducing methods, the steps/functions are met as Moriyama et al operates.

9. Claims 30- 37 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Moriyama et al further considered with Heo et al.

These claims require a table reproducing unit, and storing the centralized audio information table produced thereby.

Although the examiner can not find such elements in such terminology in the Moriyama et al reference, the examiner considers such as being inherently present, because the information contained in the video manager is considered to be in a "table" format. That is the information contained therein is reproduced and such information is normally considered management table.

Alternatively, the use of the term 'table' for this type of information is taught by the Heo et al reference, see col. 12 lines 22 plus.

It would have been obvious to one of ordinary skill in the art to modify the base reference of Moriyama et al with the teaching(s) from Heo et al modification being to provide for a user friendly system by having "tables" of the information contained on the record medium for the user to understand and interact with.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on (703) 308-4825. The fax phone numbers for the organization where


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this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700



Aristotelis M Psitos
Primary Examiner
Art Unit 2651

AMP
November 19, 2001